

Appl. No. 09/420,991
Amdt. dated June 5, 2003
Reply to Office Action of March 10, 2003

PATENT

REMARKS/ARGUMENTS

Claims 1-26, 28-31, 33-41, 59-77, 79-82, and 84-89 were pending in this application.

Claims 1-26, 28-31, 33-41, 59-77, 79-82, and 84-89 are rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, i.e., not satisfying the written description requirement.

The specification was objected to under 35 U.S.C. §112, first paragraph, as failing to support the subject matter set forth in the claims. The Office Action alleges that the limitation "with said account to exclude identification of said consumer by name" is not enabled by the disclosure.

Applicant has amended claims 1, 4, and 59. Claims 1 and 59 have been amended to correct inadvertently introduced typographical errors. Applicant has amended the specification. Applicant submits that no new subject matter has been added by this amendment.

Claims 1-26, 28-31, 33-41, 59-77, 79-82, and 84-89 remain pending in this application after entry of this amendment.

THE CLAIMS

Rejections under 35 U.S.C. § 112, first paragraph (Written Description requirement)

Guidelines for examination of patent application under 35 U.S.C. §112, first paragraph, ("Written Description" requirement) are set forth in MPEP §2163.

MPEP §2163(I) states that:

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. (MPEP §2163(I), pg. 2100-159 first column)

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MPEP §2163(I) further states:

It is now well accepted that a satisfactory description may be in the claims or any other portion of the originally filed specification. (MPEP §2163(I), pg. 2100-159 second column, emphasis added)

The unwillingness to find descriptive support when the only description was found in the claims has been clearly rejected. See MPEP §2163(I) which states:

... early opinions suggest the Patent and Trademark Office was unwilling to find written descriptive support when the only description was found in the claims; however, this viewpoint was rejected. (MPEP §2163(I), pg. 2100-159 second column, emphasis added)

There is also a strong presumption that an adequate written description of the claimed invention is present when the application is filed. See sections: MPEP §2163(I)(A), pg. 2100-160 second column; MPEP §2163(II)(A), pg. 2100-163 first column; MPEP §2163(III)(A), pg. 2100-170 second column; MPEP §2163.03, pg. 2100-172 first column.

Accordingly, the claims as filed in the original specification are considered part of the specification and can satisfy the written description requirement. This is further reiterated by the following sections of the MPEP:

MPEP §2163(I)(B) states:

The claims as filed in the original specification are part of the disclosure and, therefore, if an application as originally filed contains a claim disclosing material not found in the remainder of the specification, the applicant may amend the specification to include the claimed subject matter. (MPEP §2163(I)(B), pg. 2100-161 second column, emphasis added)

MPEP §2163.06(III) states:

The claims as filed in the original specification are part of the disclosure and therefore, if an application as originally filed contains a claim disclosing material not disclosed in the remainder of the specification, the applicant may amend the specification to include the claimed subject matter.

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(MPEP §2163.06(III)), pg. 2100-176 second column to pg.
2100-177 first column, emphasis added)

Based upon the above, Applicant submits that the pending claims satisfy the "written description" requirements of 35 U.S.C. §112, first paragraph.

The present application was filed on October 20, 1999, and is a continuation of U.S. Application No. 08/970, 526, filed on November 14, 1997, which issued as U.S. Patent No. 6,009,411. The present application incorporates by reference the entire contents of U.S. Application No. 08/970, 526 for all purposes.

The limitation of "with said account to exclude identification of said consumer by name" was recited at least in claims 27 and 46 of the present application as originally filed on October 20, 1999. The limitation was thus described in the specification as originally filed. Further, the limitation was added to claim 1, and included in new claims 78 and 83 added by a preliminary amendment filed along with the application on October 20, 1999.

Furthermore, the limitation was also cited in claims 27 and 46 of U.S. Application No. 08/970, 526, as originally filed on November 14, 1997, which is the parent of the present application and incorporated by reference in its entirety in the present application. For any material incorporated by reference, the information incorporated is as much a part of the application as filed as if the text was repeated in the application, and should be treated as part of the text of the application as filed (MPEP §2163.07(b)). Accordingly, the claimed limitation was also described in the specification of the present application via incorporation.

Since the limitation "with said account to exclude identification of said consumer by name" was recited in the claims of the present application (and its parent application), as originally filed, and since the claims are considered part of the specification per the MPEP Guidelines discussed above, Applicant submits that the specification of the present application satisfies the "written description" requirement of 35 U.S.C. §112, first paragraph for the claimed features. Upon reading the specification, including the claims, one skilled in the art would reasonably conclude that the claimed invention limitation is described in sufficient detail and that the inventor had possession of the claimed invention limitation when the application was filed.

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Additionally, Applicant submits that there are several sections in the specification of the present application, as filed, which describe the feature that the account excludes information that identifies the consumer by name. For example:

no direct consumer identification is maintained in the consumer account to preserve the anonymity of the consumer. For example, only the loyalty card identifier need be managed according to the present invention; the identity of the consumer is not needed. (Specification: page 4 lines 3-8, emphasis added)

... a unique Key identifies the account of each consumer, but not necessarily the actual identity of the consumer. (Specification: page 9 lines 28-30, emphasis added).

One skilled in the art would reasonably conclude from these descriptions that the information stored for a consumer account does not include the consumer name which directly identifies the consumer.

Further, there are several sections in the specification that describe embodiments of the present invention where the consumer is identified using a unique key rather than a name. For example, page 5 lines 34-36, page 6 lines 15-16, page 9 lines 27-32, page 11 lines 9-13, page 13 lines 10-12. These sections further indicate that consumer name information is not stored for a consumer account.

Accordingly, given the several sections in the specification that describe that the name of the consumer is not stored for the account to preserve the consumer's anonymity, and given that the limitation "with said account to exclude identification of said consumer by name" was recited in claims that were part of the present application and its parent application as originally filed, Applicant submits that the "written description" requirement for the limitation "with said account to exclude identification of said consumer by name" is satisfied. Accordingly, Applicant believes that the pending claims are in a condition for allowance.

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THE SPECIFICATION

As discussed above, Applicant submits that the specification as filed supports the subject matter set forth in the claims.

Additionally, although not needed, as allowed by MPEP (See: MPEP §2163(I)(B); MPEP §2163.06(III)), Applicant has amended the specification to include the limitation "with said account to exclude identification of said consumer by name" in the specification.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,

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